

TSRI 609.1
SN 09/581,044

Remarks

Rejection under 35 U.S.C. § 112, second paragraph:

Claim 1 is rejected for lack of clarity under 35 U.S.C. § 112, second paragraph, on the basis that the provisos is unclear. Claim 1 has been amended to overcome this rejection.

Rejection under 35 U.S.C. § 103(a):

Claim 1 is rejected as obvious under 35 U.S.C. § 103(a) over European Patent Application '145. Applicant traverses this basis for rejection. The proviso of Claim 1 has been amended to enhance its clarity. This amendment also clarifies the patentable distinction between Claim 1 and the cited compounds of European Patent Application '145. According to the amended proviso of claim 1 of the present application, R_1 can be neither hydrogen nor carbobenzyloxy-, if R_3 is hydroxyl. The cited compounds of European Patent Application '145 fall precisely into this category. Accordingly, Claim 1, as amended, is patentably unobvious over European Patent Application '145.

Rejection under 35 U.S.C. § 102(b):

Claim 23 is rejected as being anticipated by Dreyer et al. under 35 U.S.C. § 102(b). Claim 23 has been cancelled.

Rejection under 35 U.S.C. § 103(a):

Claim 3 is rejected as obvious under 35 U.S.C. § 103(a) over Handa et al. Applicant's amendment to Claim 3 obviates this basis for rejection.

Rejection under 35 U.S.C. § 102(b):

Claim 1 is rejected as being anticipated by Tam et al. under 35 U.S.C. § 102(b). The amendment to Claim 1 clarifying the proviso obviates this basis for rejection.

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Rejection under 35 U.S.C. § 102(b):

Claim 1 is rejected as being anticipated by WO Patent Application '100 under 35 U.S.C. § 102(b). The amendment to Claim 1 clarifying the proviso obviates this basis for rejection.

Rejection under 35 U.S.C. § 103(a):

Claims 10, 12-15, and 23 are rejected as being obvious under 35 U.S.C. § 103(a) over WO Patent Application '948. Applicant traverses this rejection with respect to claims 10 and 12-15. Claim 23 has been cancelled. Claims 10 and 12-15 are directed to protease inhibitors of the indicated structure wherein R¹ is a dipeptide, with the P-2 positions of this dipeptide being occupied by valine. The Examiner points out that WO Patent Application '948 discloses similar protease inhibitors wherein, *inter alia*, the P-2 positions are occupied by alanine. More particularly, the Examiner points to compounds 9, 108, and 125 of '948. The Examiner then states that it would have been obvious to a person of ordinary skill in the art to substitute valine for alanine.

Firstly, it should be pointed out that, since compound 23 has been cancelled, compound 125 of '948 is no longer relevant to this basis of rejection.

Compounds 9 and 108 of '948 employ a dipeptide for R¹ with alanine at the P-2 positions. However, '948 does not disclose or suggest that the activity of these protease inhibitors may be enhanced by substituting a valine for alanine at the P-2 positions. '948 reports, at the bottom of page 31, in an activity table, that compound 9 has an inhibitory activity of 0.58 K_i (μM) with respect to rHIV-1 protease. '948 does not disclose the activity of its compound 108. Compound 9 of '948 corresponds to compound 8 of the present application, except that compound 9 of '948 employs alanines rather than valine at the P-2 positions. In Figure 11 of the present application, Applicant discloses that compound 8 of the present application has an inhibitory activity of 62 K_i (nM) with respect to HIV-1 protease and that this compound also has inhibitory activity with respect to FIV protease. Accordingly, the present application teaches that substitution of valine for alanine at the P-2 positions enhances the activity of the

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inhibitor by approximately one order of magnitude. In contrast, '948 does not disclose or suggest any motivation for substituting valine for alanine at the P-2 positions. Accordingly, the compounds of claims 10 and 12-15 of the present application are patentably unobvious over '948.

Rejection under 35 U.S.C. § 102(b):

Claim 23 is rejected as being anticipated by Huff under 35 U.S.C. § 102(b).
Claim 23 has been cancelled.

Rejection under 35 U.S.C. § 103(a):

Claim 3 is rejected as being obvious under 35 U.S.C. § 103(a) over Slee et al.
Applicant has amended claim 3 so as to obviate this basis of rejection.

Summary:

Claims 6-9 and 19-22 have been allowed. Claims 1, 3, and 6-23 have been rejected. Claims 1 and 3 have been amended and Claim 23 has been cancelled. Applicant believes that Claims 1 and 3, as amended, and Claims 6-22 are novel, patentably clear, and patentably unobvious. Notice of Allowance of amended claims 1, 3, and 6-22 is respectfully requested.

Respectfully submitted,



Donald G. Lewis
Reg. No. 28,636
The Scripps Research Institute
10550 N. Torrey Pines Road TPC-8
San Diego, CA 92037
April 12, 2002
(858) 784-2937

APPENDIX

VERSION OF SPECIFICATION AND CLAIMS WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

Please amend the first two paragraphs following the title of the invention added
5 by amendment on June 19, 2001 as follows:

10 [International application PCT/US98/25964 was published in
English.]

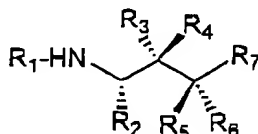
Cross-Reference to Related Application:

15 The present application claims priority from and is a national stage
application under 35 U.S.C. § 371 of copending International
Application No. PCT/US98/25964, filed December 8, 1998 and
published in English, which claims priority, under 35 U.S.C. §
119(e), from provisional application Serial No. 60/067,959, filed
December 8, 1997, the disclosures of which are hereby
20 incorporated by reference.

APPENDIX**VERSION OF SPECIFICATION AND CLAIMS
WITH MARKINGS TO SHOW CHANGES MADE**In the Claims:

A marked-up version of amended claims 1 and 3 showing the changes made are provided below. Claim 23 has been cancelled.

- 5 1. (twice amended) A protease inhibitor represented by the following structure:



wherein

10 R₁ is selected from the group consisting of hydrogen, carbobenzyloxy-,
[carbobenzyloxy-valine-,] carbobenzyloxy-glycine-valine-, carbobenzyloxy-
alanine-valine-, carbobenzyloxy-leucine-valine-, carbobenzyloxy-phenylalanine-
valine-, carbobenzyloxy-serine-valine-, carbobenzyloxy-alanine-asparagine-,
15 carbobenzyloxy-threonine-valine- and carbobenzyloxy-valine-valine-;

R₂ is selected from the group consisting of -CH₂-Phenyl, and -CH₂-CH(CH₃)₂;

20 R₃ is selected from the group consisting of hydrogen, oxygen and hydroxyl; R₄ is
selected from the group consisting of hydrogen, oxygen and hydroxyl, wherein
R₃ and R₄ are not both hydroxyl and wherein R₃ and R₄ are either not oxygen or
are a single combined oxygen forming a carbonyl group;

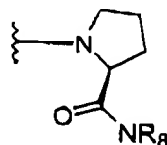
25 R₅ is selected from the group consisting of hydrogen, and oxygen; R₆ is selected
from the group consisting of hydrogen, and oxygen, wherein R₅ and R₆ are either
a single combined oxygen forming a carbonyl group or both [seperately]

APPENDIX

VERSION OF SPECIFICATION AND CLAIMS
WITH MARKINGS TO SHOW CHANGES MADE

separately hydrogen;

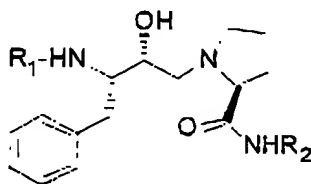
R_7 is a radical represented by the formula:



wherein R_8 is a radical selected from the group consisting of $-(H)_2$, and $-H(t\text{-Butyl})$; with a proviso that, if either $[R_2 \text{ or } R_3 \text{ or } R_4]$ is hydroxyl, [the] then R_1 is neither hydrogen nor carbobenzyloxy-.

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3. (thrice amended) A stereochemically pure protease inhibitor represented by the following structure:



wherein

R_1 is a radical selected from the group consisting of [hydrogen, carbobenzyloxy-, carbobenzyloxy-valine-,] carbobenzyloxy-glycine-valine-, carbobenzyloxy-alanine-valine-, carbobenzyloxy-leucine-valine-, carbobenzyloxy-phenylalanine-valine-, carbobenzyloxy-serine-valine-, carbobenzyloxy-threonine-valine-, carbobenzyloxy-alanine-asparagine- and carbobenzyloxy-valine-valine-; and

R_2 is a radical selected from the group consisting of $-(H)_2$, and $-H(t\text{-Butyl})$.

Please cancel Claim 23 without prejudice.

THE SCRIPPS RESEARCH INSTITUTE OFFICE OF PATENT COUNSEL 10588 N. TORREY PINES ROAD LA JOLLA, CA 92037		3412
PAY TO THE ORDER OF HONORABLE COMMISSIONER OF PATENTS AND TRADEMARKS		DATE <u>4/12/02</u> 16-88 1220
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THE UNITED STATES PATENT AND TRADEMARK OFFICE IS
REQUESTED TO IMPRESS ITS STAMP ON THIS CARD AND
PLACE SAME IN THE OUT-GOING MAIL TO SHOW THE FOLLOWING
PAPERS HAVE BEEN RECEIVED

Applicant (s): Lee, et al.
Application No.: 09/581,044
Date Filed: June 8, 2000
Title of Invention: HIV/FIV PROTEASE INHIBITORS HAVING A
SMALL P3 RESIDUE

Enclosed:

- Transmittal Form (1 page)
- Fee Transmittal (1 page)
- Petition for a 3 Month Extension of Time (1 page)
- Response to Office Action (___ pages)
- Check No. 3412 in the amount of \$920.00 for 3 month extension of time
- Certification of Mailing (included on Transmittal)